

Appin. No. 10/715,803
Docket No. GP-303124/GM2-0075

REMARKS / ARGUMENTS

Status of Claims

Claims 1-4, 7-11 and 23-25 are pending in the application and stand rejected. Applicant herein provides clarifying remarks to traverse the rejections, leaving Claims 1-4, 7-11 and 23-25 for consideration. No claim amendments have been made, and therefore under 37 CFR 1.121, no claim listing is provided herewith.

Applicant respectfully submits that the rejections under 35 U.S.C. §112, first paragraph, and 35 U.S.C. §102(b), have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

The accompanying remarks were not presented earlier because Applicant did not fully appreciate the nature of the Examiner's position until the Applicant was advised in more detail of the position by the final rejection. Accordingly, Applicant requests that the application be reconsidered in view of these accompanying remarks.

Rejection Under 35 U.S.C. §112, First Paragraph

Claim 4 stands rejected under 35 U.S.C. §112, first paragraph, as containing subject matter that was not described and supported in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner alleges that the original disclosure fails to support the limitation "a piston slidably attached to the pin via the load initiating element", and comments that "the pin 46 appears to be attached directly to the piston 50." Paper 09032005, page 2.

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that where the specification contains a written description of the invention in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains to make and use the same, then such written description complies with 35 U.S.C. §112, first paragraph.

Applicant believes the present specification and claims satisfy that burden.

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Applicant respectfully directs the Examiner's attention to elements 14, 46 and 50, Figures 9 and 10, and Paragraph [0030].

In the original application as filed, Applicant describes and illustrates a piston 50 that includes a load initiating element 14, and a pin 46, where the pin 46 is slidably arranged with load initiating element 14 (compare Figures 9 and 10). Thus, the piston 50, having load initiating element 14 a part thereof, is slidably attached to the pin 46 via the load initiating element 14, as illustrated by Figures 9 and 10, and described at Paragraph [0030].

Accordingly, Applicant submits that the specification as originally filed contains a full, clear and concise writing and illustration of "a piston slidably attached to the pin via the load initiating element", in such a manner that reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection, which Applicant considers to be traversed.

Rejections Under 35 U.S.C. §102(b)

Claims 1-3 and 7-11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Richards (U.S. Patent No. 4,691,889, hereinafter Richards).

Claims 1-3, 8-9, 12, 23-25 stand rejected under 35 U.S.C. §102(b) as being anticipated by Isaacson (U.S. Patent No. 3,788,626, hereinafter Isaacson).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if *each and every element as set forth in the claim* is found, either expressly or inherently described, *in a single prior art reference.*" Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (Emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose *all of the claimed*

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elements "*arranged as in the claim.*" Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984) (Emphasis added). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. Titanium Metals Corp. v. Banner, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Regarding Richards

In rejecting the present invention under anticipation, the Examiner alleges that Richards discloses each and every element of Claim 1 arranged as claimed, including:

"...wherein the load initiating element (36), spring (54), and compression member (50) are slideable within the housing in a first axial direction and in a second opposite axial direction in response to an axial load on the load initiating element (36), and lockable within the housing (14) in the second axial direction in response to an axial load on the compression member (50) in the second axial direction." Paper 09032005, page 3.

Here, the reference numerals are in relation to Richards, as alleged by the Examiner.

Applicant respectfully disagrees that Richards discloses each and every element of the claimed invention *arranged as claimed*. More specifically, Applicant disagrees that Richards discloses *the load initiating element (36), spring (54), and compression member (50) being lockable within the housing (14) in the second axial direction in response to an axial load on the compression member (50) in the second axial direction*.

For the anticipation rejection to stand, it is not enough to merely show each and every element, but also each and every element must shown to be *arranged as claimed*.

At Column 4, lines 38-45, Richards discloses a nut 48 (having head portion 50) that is threaded to a bolt 30.

At Column 6, lines 9-12, and lines 63-67, Richards discloses that tightening the nut 48 results in contact of the nut 48 with the locking disks 54.

At Column 7, lines 2-8, Richards discloses how the locking disks 54 bite into the side wall of housing 14 as a result of the tightening of nut 48 on bolt 30.

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Here, Applicant finds Richards to disclose locking disks 54 that are lockable within housing 14 in response to the *rotation (a torsional load)* on nut 48 (having head portion 50), and not in response to an *axial load* on the head portion 50 of nut 48.

Furthermore, Applicant finds the head portion 50 of Richards to be *axially constrained by the threads* between nut 48 and bolt 30, and only free to move when rotated. As such, the cam member 36, locking disks 54, and head portion 50 are lockable within the housing 14 *in response to rotation (a torsional load)* of the nut 48 relative to the bolt 30, and *not in response to an axial load* on the head portion 50, as alleged by the Examiner.

In view of the foregoing, Applicant submits that Richards fails to disclose each and every element of the claimed invention *arranged as claimed*, and that absent such anticipatory disclosure, Richards cannot be anticipatory.

Dependent claims inherit all of the limitations of the parent claim.

Regarding Isaacson

In rejecting the present invention under anticipation, the Examiner alleges that Isaacson discloses each and every element of Claim 1 arranged as claimed, including:

“...a spring (37) *located adjacent to* the load initiating element (46), and configured to expand in compression against the housing (10) in response to a compressive load; and

a compression member (20 or 24) slideably disposed within the housing (10) and configured to compress the spring (37) from a side opposite the load initiating element (46);

wherein the load initiating element (46), spring (37), and compression member (20, 24) *are slideable* within the housing (10) in a first axial direction and in a second opposite axial direction *in response to an axial load on the load initiating element (46)*, and *lockable* within the housing (10) in the second axial direction *in response to an axial load on the compression member (20, 24)* in the second axial direction.” Paper 09032005, page 4.

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Here, the reference numerals are in relation to Isaacson, as alleged by the Examiner.

Applicant respectfully disagrees that Isaacson discloses each and every element of the claimed invention *arranged as claimed*. More specifically, Applicant disagrees that Isaacson discloses the spring (37) *located adjacent to* the load initiating element (46), and disagrees that Isaacson discloses the load initiating element (46), spring (37), and compression member (20, 24) *being slideable* within the housing (10) in a first axial direction and in a second opposite axial direction *in response to an axial load on the load initiating element (46)*, and *lockable* within the housing (10) in the second axial direction *in response to an axial load on the compression member (20, 24)* in the second axial direction.

For the anticipation rejection to stand, it is not enough to merely show each and every element, but also each and every element must shown to be *arranged as claimed*.

At Column 2, line 65, through Column 3, line 23, and at Figure 2, Isaacson discloses an elastomeric material (*not a spring*) (37) located *apart from* a Belleville spring (46), with a ring (38), a snap ring (44), and a portion of a friction shoe (36) disposed therebetween. As such, Isaacson *necessarily cannot disclose* a spring (37) located *adjacent to* the load initiating element (46), as alleged by the Examiner.

At Column 3, lines 17-37, Isaacson discloses a Belleville spring (46) that serves to compress the elastomeric material (37) against the friction shoe (36) to cause the friction shoe (36) to be forced against housing (10, 18), thereby *frictionally resisting movement* between the friction shoe (36) and the housing (10), which works against any disclosure of a load initiating element (46), spring (37), and compression member (20, 24) *being slidable* within the housing (10) *in response to* an axial load on a load initiating element (46).

At Column 3, lines 35-37, Isaacson specifically states: "*The preload of friction shoe 36 against the outer tubular member 18 resists such movement of the friction shoe 36.*" Here, Isaacson specifically states that movement of the friction shoe 36, and therefore movement of the elastomeric material 37, is frictionally resisted as a result of

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the preload from the Belleville spring 44, which appears to be exactly opposite to what the Examiner alleges.

As such, Applicant submits that the Isaacson load initiating element (46), elastomeric material (37), and compression member (20, 24) cannot be both *slideable as claimed and frictionally held in place as disclosed in Isaacson* within the housing (10) *in response to an axial load on the load initiating element (46)*.

At Column 3, lines 37-42, Isaacson discloses an increase in frictional loading between friction shoe 36 and the tube 18 as a result of a sudden impact force. As such, Applicant does not find Isaacson to disclose a slideable arrangement in response to one loading condition and a locking arrangement in response to another loading condition, as claimed.

In view of the foregoing, Applicant submits that Isaacson fails to disclose each and every element of the claimed invention *arranged as claimed*, and that absent such anticipatory disclosure, Isaacson cannot be anticipatory.

Dependent claims inherit all of the limitations of the parent claim.

Furthermore, the Examiner alleges that Isaacson discloses each and every element of Claim 1 including a *spring (Isaacson reference numeral 37) being slideable within the housing 10*. Paper 09032005, page 4. Emphasis added.

Applicant respectfully disagrees that Isaacson discloses a *spring 37* being *slideable* within the housing 10.

As discussed above, Applicant finds Isaacson to disclose a friction shoe 36 that is preloaded against housing 10 by Belleville spring 46, where the friction shoe 36 is friction loaded even more during an impact condition in response to the elastomeric material 37 being compressed and expanded. Nowhere does Applicant find Isaacson to disclose elastomeric material (the claimed spring in the instant application) 37 being *slideable* within housing 10.

Contrary to the Examiner's allegation, Applicant finds Isaacson to disclose elastomeric member 37 to be *axially confined* at its leftward end... and at its rightward end. Column 3, lines 8-10 (emphasis added). Since elastomeric member 37 is disclosed

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to be *confined at both ends*, it necessarily follows that elastomeric member 37 *cannot also be slideable* within the housing 10.

Accordingly, Applicant respectfully submits that Isaacson does not disclose each and every element of the claimed invention *arranged as claimed*, and therefore Isaacson cannot be anticipatory.

Regarding Claim 4 Separately

While not specifically rejected on grounds of anticipation, Applicant nonetheless submits that Richards and Isaacson each separately fail to disclose:

“...a piston slideably attached to the pin *via the load initiating element*,
...wherein the piston, load initiating element, and pin are configured to slide the load initiating element, spring and inner tube within the outer tube *in the first and second axial directions in response to an axial load on the piston sufficient to overcome the resistance to movement without loading the spring into a self locking mode.*”

Dependent claims inherit all of the limitations of the parent claim and any intervening claim.

In view of the foregoing, Applicant submits that Richards and Isaacson do not separately disclose all of the claimed elements, including their claimed attributes, arranged as in the claim, and respectfully submits that absent anticipatory disclosure in either Richards or Isaacson of each and every element of the claimed invention arranged as in the claim, both Richards and Isaacson cannot separately be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

In light of the forgoing, Applicant respectfully submits that the proposed arguments comply with 37 C.F.R. §1.116 and should therefore be entered, and with their entry that the Examiner's rejections under 35 U.S.C. §112, first paragraph, and 35 U.S.C. §102(b), have been traversed, and that the application is now in condition for allowance.

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Such action is therefore respectfully requested.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,
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